

The opinion in support of the decision being entered today is **not** binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HAL C. DANBY
and ERIC A. FAULKNER

Appeal No. 1998-2911
Application 08/314,345¹

HEARD: April 6, 2000

Before COHEN, FRANKFORT, and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Hal C. Danby et al. appeal from the final rejection of claims 35 and 36. Claims 1 through 34, the only other claims pending in the application, stand allowed.

¹Application filed September 28, 1994 for the reissue of U.S. Patent No. 5,151,019, granted on September 29, 1992, based on Application 07/430,851, filed November 2, 1989.

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THE INVENTION

The invention relates to a pumping device for supplying intravenous fluids to a medical patient. In general, the device includes means for accommodating a length of tubing, means for deforming the tubing to reduce its volume and valve means adjacent opposed sides of the deforming means for restricting the flow of liquid through the tubing. A copy of claims 35 and 36 appears in the appendix to the appellants' main brief (Paper No. 20).

THE REJECTION

Claims 35 and 36 stand rejected under 35 U.S.C. § 251 as attempting to improperly recapture subject matter surrendered to obtain the patent sought to be reissued.

Reference is made to the appellants' main and reply briefs (Paper Nos. 20 and 24) and to the examiner's answer (Paper No.

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21) for the respective positions of the appellants and the examiner with regard to the merits of this rejection.²

DISCUSSION

Reissue claims 35 and 36 are broadened versions of claims 1 and 2 in U.S. Patent No. 5,151,019.³ The record in U.S. Patent No. 5,151,019 shows the following with respect to the prosecution of claims 1 and 2.

A. On February 4, 1992, the examiner entered a final rejection (Paper No. 16) wherein claims 1 and 2 were rejected under 35 U.S.C. § 103 as being

²Although the statement of rejection in the examiner's answer refers to "the equitable doctrine of recapture," the accompanying explanation indicates that the rejection is actually based on the provisions of 35 U.S.C. § 251. This is in accord with the prevailing view that the prohibition against the improper recapture of surrendered subject matter via reissue has statutory underpinnings. See, for example, Hester Industries Inc. v. Stein Inc., 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998) and MPEP § 1412.02.

³Allowed reissue claim 1 is identical to patent claim 1. Allowed reissue claim 2 is identical to patent claim 2 except for the inclusion of a phrase (not at issue here) which was inadvertently omitted from the patent due to a printing error.

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unpatentable over

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U.S. Patent No. 4,549,860 to Yakich in view of U.S.
Patent No. 4,559,038 to Berg et al.

B. On April 7, 1992, the examiner held an interview with one of the applicants, Mr. Danby, and his counsel, Mr. Kuesters. The results of the interview were recorded by the examiner in an interview summary (Paper No. 18) which states in pertinent part that

Claim 1 is to be amended to add that members are arranged for controlled relative movement in opposed [sic, opposed] directions tranverse [sic, transverse] to the tube. . . . Claim language read over Yasich [sic, Yakich] and German reference.^[4] Amendment will be entered.

C. On April 8, 1992, applicants' counsel filed a paper (Paper No. 19) amending claims 1 and 2 to specify, inter alia, that the deforming means of the claimed pumping

⁴The examiner identified the German reference elsewhere in the interview summary as German document 2939212 which had been cited in an information disclosure statement filed March 10, 1992 (Paper No. 17).

device "comprises members arranged for controlled relative
movement in opposed directions in parallel planes
transverse to the direction of liquid passage within said
tubing." In accompanying remarks, counsel stated that

Claim 1 submitted herewith differs slightly from the wording of the proposed Claim 1 discussed during the April 7, 1992 interview by the recitation that the members of the deforming means have controlled relative movement in -- parallel planes-- transverse to the direction of fluid flow consistent with the fact that the tubing is in fact deformed over a surface area defined by parallel planes, not a single plane, as otherwise suggested by the proposed claim language discussed during the April 7, 1992 interview. Claim 2 is amended herewith to incorporate the same changes added to Claim 1, thereby to define more definitively the patentably distinguishing structure of the claimed deforming means of Applicants' invention [page 5].

Counsel added that

[a]s explained during the April 7, 1992 interview, none of the prior art references of record, including the Yakich patent, teaches a deforming means including members arranged for controlled relative movement in opposed directions in parallel planes transverse to the direction of liquid passage, with the resulting operation as recited in the amended Claims 1 and

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2 [pages 6 and 7].

D. On April 13, 1992, the examiner mailed a Notice of Allowability (Paper No. 20) indicating that all of the

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pending claims, including amended claims 1 and 2, were allowed.

The appellants filed the instant reissue application within two years from the grant of the original patent alleging that they had

claimed less than they had a right to claim in the patent by not including claims having the scope of claims 35 and 36 of this reissue patent application. Claims 35 and 36 of the reissue application correspond to claims 1 and 2 of the patent with the exception of the description of the "deforming means". Claims 1 and 2 of the patent state that the deforming means comprises members arranged for controlled relative movement in opposed directions in parallel planes transverse to the direction of liquid passage within tubing. Claims 35 and 36 state that the deforming means comprises members arranged for controlled relative movement in opposed directions which extend transversely to the direction of liquid passage within said tubing [original and supplemental reissue declarations, paragraph 4].

Thus, reissue claims 35 and 36 differ from patent claims 1 and 2 (and from allowed reissue claims 1 and 2) in that they do not include the "in parallel planes" language inserted into the patent claims via the amendment filed April 8, 1992 which

resulted in the issuance of the patent. In rejecting claims 35 and 36, the examiner takes the position that

the "parallel planes" limitation [was] deliberately added to claims in the application for the patent . . . upon which the present reissue . . . is based to overcome prior art and render those claims patentable. "Error" within the meaning of 35 U.S.C. § 251 does not include deliberate decisions to surrender specific subject matter in order to overcome prior art. Appellant's [sic] representative voluntarily added the "parallel planes" limitation to the claims in the after final amendment of April 8, 1992 in order to over come the prior art and define the patentable structure of the applicants['] invention. Therefore, the reissue claims are an attempt to impermissibly recapture what the applicants surrendered in the original prosecution [answer, page 4].

The appellants, on the other hand, submit that the prosecution history of the application which matured into the patent clearly demonstrates that the "in parallel planes" language absent from reissue claims 35 and 36 was not added to patent claims 1 and 2 to overcome the prior art.

The recapture rule rooted in 35 U.S.C. § 251 prevents a patentee from regaining through reissue subject matter surrendered in an effort to obtain allowance of original

claims. In re Clement, 131 F.3d 1464, 1468-69, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997). The first step in applying the recapture rule is to determine whether and in what aspect the reissue claims are broader than the patent claims; the second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter by looking to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection. Id.

The application of the first step to the present fact situation is fairly simple and straightforward and is not the subject of dispute. Reissue claims 35 and 36 are broader than corresponding patent claims 1 and 2 in that they do not include the "in parallel planes" language.

The controversy in this appeal involves the application of the second step, i.e., whether the "in parallel planes" language absent from claims 35 and 36 relates to subject matter surrendered in an effort to overcome the prior art and obtain allowance of patent claims 1 and 2. Based on our

review of the patent's prosecution history, we are satisfied that the "in parallel planes" language does not relate to surrendered subject matter.

The interview summary in the patent record fairly reflects an agreement between the examiner and counsel that claim 1, and by implication claim 2, would overcome the prior art if amended to include the limitation that the deforming means comprises members arranged for controlled relative movement in opposed directions transverse to the direction of liquid passage within the tubing. The interview summary makes no mention of the additional "in parallel planes" limitation. The appellants subsequently added both limitations to claims 1 and 2 with the explanation that the "in parallel planes" limitation was consistent with the fact that the tubing is deformed over a surface area defined by parallel planes rather than a single plane. This is the only specific reason expressed in the prosecution history of the patent as to why the "in parallel planes" limitation was added to claims 1 and 2. There is nothing in the appellants' explanation or in any

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other part of the prosecution history which indicates that either the examiner or the appellants considered the "in parallel planes" limitation necessary to overcome the prior art. To infer otherwise from the remarks accompanying the amendment which mentioned both limitations in urging the patentability of claims 1 and 2 over the prior art would be unwarranted. Indeed, given the context of the "in parallel planes" limitation within the other added limitation, it would have been surprising had counsel not referred to both in arguing for the allowance of the claims.

In light of the foregoing, the absence of the "in parallel planes" language from reissue claims 35 and 36 does not pose a recapture problem. Accordingly, we shall not sustain the standing 35 U.S.C. § 251 rejection of these claims.

The decision of the examiner is reversed.

REVERSED

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	IRWIN CHARLES COHEN)	
	Administrative Patent Judge)	
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)	BOARD OF PATENT
	CHARLES E. FRANKFORT)	
APPEALS			
	Administrative Patent Judge)	AND
)	
INTERFERENCES			
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